

B. Claims 15 and 16

During the Interview, the allowability of newly-presented Claims 15 and 16 was discussed and Examiner Tovar indicated that these claims were free of all grounds of rejection presented in the Official Action and were therefore allowable. That is, these claims are not improper Markush claims and there is "reasonable assurance" that the compounds of Claim 15 and the compositions of Claim 16 are useful in view of the data presented regarding these compounds in the table on page 37. Additionally, the Examiner agreed that Claims 15 and 16 were unobvious over Heeres, et al., and Heeres, the two cited references. Since the compounds of Claim 15 are unobvious over the other compounds in Claim 1, they must also be unobvious over the reference compounds, which are even more different.

It is therefore respectfully submitted that Claims 15 and 16, as well as species Claims 4, 5, 8, 9, and 10 included within generic Claim 15, are all allowable and such action is earnestly solicited.

C. Claims 1 and 11 - Improper Markush

The rejection of Claims 1 and 11 as improper Markush claims is respectfully traversed. The Examiner is respectfully referred to revised Section 803 of the Manual of Patent Examining Procedure, a photocopy of which is enclosed. This section clearly contemplates that Markush-type claims including independent and distinct inventions (i.e., embracing compounds that are unobvious over each other) are proper and provides a procedure for examining such claims. In view of the Examiner's indication that Claims 15 and 16 (as well as the species claims included therein) are allowable, he is respectfully urged to continue examination on the merits of all the compounds within Claim 1.

D. Claims 1 and 11 - 35 USC 112

The rejection of Claims 15 and 16 under 35 USC 112 (first paragraph) or 35 USC 101 is deemed moot in view of the Examiner's agreement during the Interview that the utility of these claims is evidenced sufficiently by the presented data. The rejection of Claims 1 and 11 on similar grounds is respectfully traversed. The application presents considerable data regarding the testing of compounds having a variety of Y substituents against the commonly-encountered fungus candida. If the Examiner has some reason for doubting the truth of Applicants' disclosure or believes that one skilled in the art is not taught thereby how to use the claimed invention, he is respectfully requested to present his reasons. In the absence of supporting reasons, it is believed that this rejection is without merit.

With regard to the controversy about In re Marzocchi, Applicants' Attorney does not believe that the particular phrase employed, either "reasonable assurance" or "undue experimentation" is important. What is at issue here is the Examiner's disbelief that all of the compounds claimed possess the asserted utility. It is respectfully submitted that his unsupported skepticism is insufficient grounds for a rejection.

In re Goffe, 191 USPQ 429 (C.C.P.A. 1976) has nothing to do with the present rejection, since the issue in Goffe was whether undue experimentation would be required to determine the "suitable agglomerable materials" required in the claim. Since the C.C.P.A. reversed this rejection, this decision can hardly assist the Examiner in making a similar rejection. The footnote referred to by the Examiner at the bottom of page 431 of the decision simply indicates that the ground for reversal in this case was not Marzocchi.

In the present situation, there is no functional language in the claim such as Goffe's "agglomerable". The simple issue here is whether the truth of Applicants' disclosure is believed. It is respectfully submitted that Marzocchi is controlling; reasons must therefore be presented by the Examiner to support his rejection. Since no reasoning has been presented, it is respectfully requested that the rejection of Claims 1 and 11 under these grounds be withdrawn.

E. Claims 1 and 11 - 35 USC 103

Finally, the rejection of Claims 1, 4, 5, 8, 9, 10, 11, 15, and 16 as being unpatentable under 35 USC 103 over Heeres, et al., and Heeres is traversed. Initially, generic Claims 15 and 16, as well as species Claims 4, 5, 8, 9, and 10 included within the genus of Claim 15, are believed to be allowable in view of the discussion during the Interview.

Furthermore, Claims 1 and 11 are also believed allowable. The Examiner has indicated that Claim 1 embraces compounds that are unobvious over each other. If this is so, how can the Examiner maintain that these claims are obvious over Heeres and Heeres, et al., which references disclose compounds which are much more remote than the various compounds contained within Claim 1? It is respectfully submitted that he cannot so maintain and must therefore withdraw the rejection on these references.

The Examiner has asserted that the prior art teaches the noncriticality of the substituent Y, but has provided no reference demonstrating this. The Heeres and Heeres, et al., references disclose only prior art imidazole and triazole dioxolane compounds similar in part to the compounds claimed herein. However, there is no suggestion about the effect of the novel phenoxy substituents in the claimed compounds.

F. Drawings

The requirement for regular drawings for the flow diagrams at page 31 is deemed to be withdrawn in view of the comments of the Examiner during the Interview that he would no longer adhere to this requirement.

G. Conclusion

It is respectfully submitted that Claims 1-16, all the claims in the application, are allowable. Withdrawal of the rejections and allowance of the claims is therefore earnestly solicited.

Respectfully submitted,


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